

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: TANGA=11

In re Application of:)	Confirmation No.: 7184
)	
Michifumi TANGA et al)	Art Unit: 1634
)	
I.A. Filing Date: 08/18/2003)	Examiner: R. T. Crow
371(c) Date: October 28, 2005)	
)	July 13, 2007
U.S. Appln. No.: 10/525,394)	
)	
For: SOLID SUPPORT AND METHOD)	
OF MASS SPECTROMETRY OF...)	

REPLY TO RESTRICTION REQUIREMENT OFFICE ACTION

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Sir:

Applicants are in receipt of the Office Action mailed June 15, 2007, entirely in the nature of a restriction requirement based on alleged lack of unity of invention under the applicable PCT Rules 13.1 and 13.2. Applicants reply below.

First, however, applicants respectfully request the PTO to acknowledge receipt of applicants' papers filed under Section 119.

Restriction has been required between what the PTO deems as being two patentable distinct inventions which are said to lack the same or corresponding special technical

features. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, presently claims 1-7 and 9, with traverse and without prejudice.

The position of the PTO is that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because the two groups lack the same or corresponding special technical features as required by PCT Rule 13.2, in view of the disclosure of Sosnowski USP 6,051,613 which is cited as allegedly destroying unity of invention. Applicants do not necessarily agree; however, even if the examiner is correct, Groups I and II would share a more narrow corresponding special technical feature. For example, if claim 1 were unpatentable in view of Sosnowski¹ and claim 2 were patentable over Sosnowski, claim 8 (Group II) would be made to depend from claim 2, and thus the two Groups would share the same or corresponding special technical features.

Moreover, the examiner should be guided by the second paragraph of MPEP 803 which **requires** a search and examination of an entire application if it would not constitute a serious burden to do so, **even when** the requirement is otherwise correct. Applicants cannot see that

¹ Applicants take no position on this point at the present time, as Sosnowski has not been applied against any of applicants' claims.

Appln. No. 10/525,394
Amd. dated July 13, 2007
Reply to Office Action of: June 15, 2007

any substantial burden would be created by examining claim 8 along with claims 1-7 and 9.

Withdrawal of the requirement and examination of all the claims on the merits are therefore respectfully requested.

Applicants now respectfully await the results of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By /SN/
Sheridan Neimark
Registration No. 20,520

SN:kg
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\O\Ohta\TANGA11\pto\2007-07-13PCTRestrictionReply.doc